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Filing date: **12/05/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219051
Party	Defendant Asante Solutions, Inc.
Correspondence Address	STEPHANIE S. BRANNEN WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL RD PALO ALTO, CA 94304-1050  trademarks@wsgr.com
Submission	Answer and Counterclaim
Filer's Name	Stephanie S. Brannen
Filer's e-mail	trademarks@wsgr.com
Signature	/Stephanie S. Brannen/
Date	12/05/2014
Attachments	Answer to Notice of Opposition and Counterclaim Petition to Cancel.pdf(874381 bytes )

Registrations Subject to the filing

Registration No	3812065	Registration date	06/29/2010
Registrant	Spiracur Inc. 1180 Bordeaux Drive Sunnyvale, CA 94089 UNITED STATES		

Goods/Services Subject to the filing

Class 010. First Use: 2009/09/25 First Use In Commerce: 2009/12/17  
All goods and services in the class are requested, namely: Medical devices, namely, wound treatment apparatus and instruments

Registration No	4003768	Registration date	07/26/2011
Registrant	Spiracur Inc. 1180 Bordeaux Drive Sunnyvale, CA 94089 UNITED STATES		

Goods/Services Subject to the filing

Class 010. First Use: 2010/08/13 First Use In Commerce: 2010/08/13  
All goods and services in the class are requested, namely: Medical devices, namely, wound treatment apparatus and instruments; wound therapy system comprised of wound treatment apparatus, wound dressings, valves, tubes and straps with holsters; accessory for wound treatment apparatus, namely, strap and holster used to secure apparatus to patient

Registration No	4199890	Registration date	08/28/2012
Registrant	Spiracur Inc. 1180 Bordeaux Drive Sunnyvale, CA 94089		

	UNITED STATES
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## Goods/Services Subject to the filing

Class 010. First Use: 2011/10/19 First Use In Commerce: 2012/02/24

All goods and services in the class are requested, namely: Medical devices, namely, wound treatment apparatus and instruments and surgical and post-surgical incision care apparatus and instruments; wound and surgical incision care and therapy systems comprised primarily of wound and incision care treatment apparatus, wound dressings, valves, tubes, straps, fluid removal conduits, pressure delivery conduits, incision approximation supports and incision tension relief supports; accessory for wound treatment apparatus, namely, strap and clip used to secure apparatus to patient

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SPIRACUR INC.,	)	
	)	Opposition No. 91219051
Opposer,	)	
	)	
v.	)	Application Serial No. 85921995
	)	
ASANTE SOLUTIONS, INC.,	)	
	)	
Applicant.	)	
	)	
	)	
	)	

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**ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM/**

**PETITION TO CANCEL**

Asante Solutions, Inc. ("Applicant"), by and through its attorneys, Wilson Sonsini Goodrich & Rosati, hereby answers the Notice of Opposition against Application Serial No. 85921995 as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1, and on that basis denies those allegations.
2. Applicant admits that USPTO records identify Opposer as the owner of Registration Nos. 3812065, 4003768, and 4199890, referenced in Paragraph 2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 2, and on that basis denies those allegations.
3. Applicant denies the allegations in Paragraph 3.
4. Applicant admits the allegations in Paragraph 4.
5. Applicant denies the allegations in Paragraph 5.

6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6, and on that basis denies those allegations.

7. Applicant denies the allegations in Paragraph 7.

8. Applicant denies the allegations in Paragraph 8.

9. Applicant denies the allegations in Paragraph 9.

Applicant is not required to answer the allegations in the final paragraph of the Notice of Opposition, which merely describes the relief requested.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense**

10. Opposer's Notice of Opposition fails to set forth facts sufficient to entitle the Opposer to the relief sought under 15 U.S.C. § 1052(a). Specifically, Opposer has failed to adequately allege the following: (1) that Applicant's ASANTE SNAP mark is the same or a close approximation of Opposer's previously used name or identity; (2) that Applicant's ASANTE SNAP mark would be recognized as such by purchasers as pointing uniquely and unmistakably to Opposer; (3) Opposer is not connected with the goods that are sold by Applicant under its ASANTE SNAP mark; and (4) Opposer's name or identity is of sufficient fame or reputation that when Applicant's ASANTE SNAP mark is used on Applicant's goods, a connection with Opposer will be presumed.

#### **Second Affirmative Defense**

11. Opposer is not entitled to relief because Opposer's pleaded trademarks are descriptive and fail to serve as indicators of source.

## COUNTERCLAIM/PETITION TO CANCEL

12. Asante Solutions, Inc. (“Petitioner”) believes that it has been and will be damaged by Registration Nos. 3812065, 4003768, and 4199890 (the “Registrations”) because, among other reasons, Spiracur Inc. (“Respondent”) has relied upon and asserted such registrations in the above-captioned opposition against Petitioner’s application to register the mark ASANTE SNAP (Opposition No. 91219051). Petitioner hereby petitions, pursuant to TBMP §§ 309 and 313, to cancel the Registrations, as follows:

13. Petitioner is a Delaware corporation with its principal place of business at 352 East Java Drive Sunnyvale, CA 94089. Petitioner is a developer and provider of innovative insulin pumps.

14. Petitioner is informed and believes, and therefore alleges, that Respondent is a Delaware corporation providing wound-healing products.

15. On May 2, 2013, Petitioner filed with the United States Patent and Trademark Office (“USPTO”) an application for the mark ASANTE SNAP for a drug delivery pump, in International Class 010. Petitioner expressly disclaimed any right to use the word “SNAP” apart from the mark as shown in the application.

16. Petitioner is informed and believes, and therefore alleges, that Respondent is the record owner of federal Registration No. 3812065 for the mark SNAP for “medical devices, namely, wound treatment apparatus and instruments,” in International Class 010, which was registered on June 29, 2010.

17. Petitioner is informed and believes, and therefore alleges, that Respondent is the record owner of federal Registration No. 4003768 for the mark SNAP (and design) for “medical devices, namely, wound treatment apparatus and instruments; wound therapy system comprised

of wound treatment apparatus, wound dressings, valves, tubes and straps with holsters; accessory for wound treatment apparatus, namely, strap and holster used to secure apparatus to patient,” in International Class 010, which was registered on July 26, 2011.

18. Petitioner is informed and believes, and therefore alleges, that Respondent is the record owner of federal Registration No. 4199890 for the mark CISNAP for “medical devices, namely, wound treatment apparatus and instruments and surgical and post-surgical incision care apparatus and instruments; wound and surgical incision care and therapy systems comprised primarily of wound and incision care treatment apparatus, wound dressings, valves, tubes, straps, fluid removal conduits, pressure delivery conduits, incision approximation supports and incision tension relief supports; accessory for wound treatment apparatus, namely, strap and clip used to secure apparatus to patient,” in International Class 010, which was registered on August 28, 2012.

19. Petitioner has ascertained that the marks in the Registrations are descriptive and not sufficiently distinctive to merit registration on the USPTO’s Principal Register.

20. The term “snap” has been and is commonly used to refer generally to the snapping action or mechanism of a medical device, apparatus, or instrument. Specifically, “snap” is a fastening, or the act of fastening, characterized by closing, locking, or fitting into place with a click.

21. Petitioner is informed and believes, and therefore alleges, that one of the primary features of the goods described in the Registrations is a cartridge that “snaps” into a holder attached to the consumer, allowing the SNAP or CISNAP device to be hidden under clothing. Accordingly, the term “snap” describes a feature or characteristic of Respondent’s goods.

22. The trademark in Registration No. 3812065, consisting solely of the word “SNAP,” does not identify or distinguish Respondent’s goods or the source of such goods. Accordingly, the mark in Registration No. 3812065 is descriptive.

23. The trademark in Registration No. 4003768 consists of the word “SNAP” with a triangle design (representing the letter “A”). The primary feature of this mark is the word “SNAP,” which is not disclaimed. The trademark in Registration No. 4003768 does not identify or distinguish Respondent’s goods or the source of such goods. Accordingly, the mark in Registration No. 4003768 is descriptive.

24. The trademark in Registration No. 4199890 consists of the compound term “CISNAP.” Petitioner is informed and believes, and therefore alleges, that “CI” and “SNAP” are distinctly separable elements which comprise this compound word mark.

25. Petitioner is informed and believes, and therefore alleges, that “CI” refers to “closed incision,” which describes an incision that has been closed via suture or staple.

26. Petitioner is informed and believes, and therefore alleges, that one of the primary characteristics of the goods described in Registration 4199890 is its specific application to closed incisions. The term “CISNAP” describes a product with a snapping action or mechanism applicable to closed incisions. Accordingly, the term “CISNAP” describes a feature or characteristic of Respondent’s goods.

27. The trademark in Registration No. 4199890 does not identify or distinguish Respondent’s goods or the source of such goods. Accordingly, the mark in Registration No. 4199890 is descriptive.

28. Petitioner has been and will be damaged by the continued registration of the marks in the Registrations because, among other reasons, Respondent has relied upon and

asserted the marks in the Registrations in the above-captioned opposition against Petitioner's application to register the mark ASANTE SNAP. Continued registration of the marks in the Registrations will also damage and injure Petitioner and others because, among other reasons, the Registrations adversely affect the ability of third parties to use the terms "CI" and "snap" to accurately refer to goods intended for closed incisions or utilizing a snapping feature.

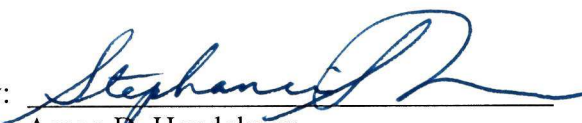
WHEREFORE, Petitioner prays that the Registrations be cancelled in their entirety and that the Notice of Opposition be dismissed.

Petitioner authorizes payment of the required filing fee of \$900 from its counsel's USPTO Deposit Account. Please charge the fee to Deposit Account No. 232415.

Dated: December 5, 2014

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

By:   
Aaron D. Hendelman  
Stephanie S. Brannen

Attorneys for Applicant/Petitioner  
ASANTE SOLUTIONS, INC.

Please address all communications concerning this proceeding to:

Aaron D. Hendelman  
Stephanie S. Brannen  
Wilson Sonsini Goodrich & Rosati, P.C.  
650 Page Mill Road  
Palo Alto, California 94304-1050  
Telephone: 650-493-9300  
Facsimile: 650-493-6811  
Email: [trademarks@wsgr.com](mailto:trademarks@wsgr.com)



**CERTIFICATE OF SERVICE BY MAIL**

I, Shelie Plourde, declare:


I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served **ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM/PETITION TO CANCEL** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Charlene M. Krogh  
Dorsey & Whitney LLP  
1400 Wewatta Street, Suite 400  
Denver, CO 80202-5549

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on December 5, 2014.

  
\_\_\_\_\_  
Shelie Plourde